

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed June 28, 2005. At the time of the Final Office Action, Claims 1-3, 5-10, 12-16 and 18-23 were pending in this Application. Claims 4, 11 and 17 were previously cancelled by Applicants without prejudice or disclaimer. Claims 1-3, 5-10, 12-16 and 18-23 were rejected. Claims 1, 10 and 16 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-3, 6-10, 12, 14-16, and 20-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,466,989 issued to Hslao-Wei Chu et al. ("Chu") in view of U.S. Patent 6,490,297 issued to Mark H. Kraml et al. ("Kraml"). Applicants respectfully traverse and submit the cited art combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious. In order to make obvious Applicant's claimed invention, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent Claim 1 recites, among other steps "generating an illumination signal on the first computing component and the second computing component indicative of the cabling connection to be made." Emphasis added. Independent Claim 10 recites, among limitations, a program of instructions "operable to generate at least one illumination signal on a first and second computing component . . . indicative of a cabling connection to be made." Independent Claim 16 is directed to a computing system that includes, among other features, a computing component, "operable to generate at least one illumination signal on the first computing component indicative of a cabling connection to be made . . . and to generate at least one illumination signal on the second computing component of a cabling connection to be made."

Examiner cites to the combination of Chu and Kraml as rendering obvious Independent Claims 1, 10 and 16. Specifically, Examiner cites to Chu as generating signals on the first and second computing components indicative of the cabling connection that is to

be made. The Chu reference is directed to a network connection device an interface circuit, a switching array and a controlling circuit to make a connection between network terminals.

See Col. 2, lines 16-27. More specifically:

The method of operating the aforementioned network connection device for connecting to a network cable is as follows. First, as soon as the network connection device is physically connected to the wires inside a network cable, a signal is emitted from the controlling circuit to the switching array requesting that the positive receiving terminal and the negative receiver terminal of the interface circuit be connected to a pair of signal-carrying wires inside the cable. Next, the controlling circuit picks up the signals from the positive receiving terminal and the negative receiving terminal to determine if the polarity of the two wires are correctly made. If proper polarity is made, nothing changes.

However, if the polarity of the wiring connection is incorrect, the controlling circuit signals the switching array to swap their connection. Thereafter, the controlling circuit sends a signal to the switching array so that the positive transmitting terminal and the negative transmitting terminal are connected to a pair of unattached wires inside the network cable. Subsequently, a packet is sent from the controlling circuit to the network cable through the positive transmitting terminal and the negative transmitting terminal. The controlling circuit then waits for an acknowledgement packet from the network cable through the positive receiving terminal and the negative receiving terminal. On receiving the acknowledgement packet regarding the polarity connection to the network cable, a proper controlling signal can be sent to the switching array. If the original connection is judged to be in error, wiring connections from the positive transmitting terminal and negative transmitting terminal to the wires inside the network cable can be swapped.

Col. 2, line 49-Col. 3, line 11.

As is clearly indicated, a signal to control circuit is initiated only after a network connection device is connected to a network cable. As such, any signal generated cannot be indicative of a cabling to be made since the cabling in question has already been accomplished. The teachings of Chu are directed to first making a cabling connection and

then utilizing a network connection device and a switching array to correctly match the connected terminals.

Additionally, Chu also fails to disclose, teach or suggest generating an illumination signal on the first and second computing component as recited. The use of any illumination signal would be inconsistent with the purpose of Chu, which is to provide an automated wiring device and thus would have no need for an illumination signal which, of course, would be provided only for the benefit of a user or technician installing cabling.

Additionally Kraml also fails to disclose, teach or suggest generating an illumination signal as recited. Accordingly, Applicants respectfully submit that the combination of Chu and Kraml fails to render obvious Independent Claims 1, 10, 16 and Claims 2-3, 6-9, 12, 14, 15 and 20, 23 which depend therefrom. Applicants request reconsideration, withdrawal of the § 103 rejections and full allowance of Claims 1-3, 6-10, 12, 14-16 and 20, 23.

Claims 5, 13, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chu and Kraml et al. in view of U.S. Patent 5,761,294 issued to Shmuel Shaffer et al. ("Shaffer"). Applicants respectfully traverse and submit the cited art combination, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Examiner cites to the combination of Chu, Kraml and Schaffer as rendering obvious Claims 5, 13, 18 and 19. Specifically, Examiner cites to Shaffer as teaching an LED device (a visual indicator).

In order to combine references for an obviousness rejection, there must be some teaching, suggestion or incentive supporting the combination. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989). The fact that a prior art device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In addition, it is also improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

As discussed above, because Chu is directed at an automated wiring method there is no motivation in Chu to include a visual indicator such as an LED as taught by Shaffer. There is also no motivation in Kraml to make the suggested combination. Applicants submit that there is inadequate motivation to combine Shaffer with Chu and Kraml as suggested. For at least these reasons, Applicants request reconsideration, withdrawal of the § 103 rejections and full allowance of Claims 5, 13, 18 and 19.


CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of remaining Claims 1-23 as amended.

Applicants believe there are no additional fees due, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0383 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2548.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants


Brian E. Szymczak
Reg. No. 47,120

SEND CORRESPONDENCE TO:
CUSTOMER NO. **23640**
512.322.2548
512.322.8383 (fax)

Date: 8/29/05